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Attorney Docket No.: 24443-501 UTIL



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/087,621 Confirmation No. 7946
Applicants : Remsen, et al.
Filed : March 1, 2002
TC/A.U. : 2162
Examiner : Chen, Chongshan
Customer No. : 35437
For : **MANAGING TAXONOMIC INFORMATION**

Mail Stop: RESPONSE
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

In response to an Office Action, dated May 19, 2005, Applicants submit the following Response and Request for Reconsideration. A Response to the Office Action is due on/before Monday, June 20, 2005 (June 19, 2005 falling on a Sunday).

Restriction Requirement

The Office Action dated May 19, 2005 included a restriction/election requirement set forth as follows:

Group I: Claims 32, 33, 38, 39, 60, 61, and 67-71, drawn to organizing taxonomic information and identifying information associated with a organism based on a second name of the organism, classified in class 707, subclass 5.

Group II: Claims 40-59 and 62-66, drawn to creating a database of classifications, classified in class 707, subclass 103R.

In response and to comply with the requirement of 37 CFR 1.143, Applicants respectfully elect, with traverse, the claims of **Group I (Claims 32, 33, 38, 39, 60, 61 and 67-71)**.

The Examiner indicates that the inventions of Groups I and II are distinct because they are related as subcombinations disclosed as usable together in a single combination. Pursuant to M.P.E.P. 806.05(d) the Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. The Examiner contends that the invention in Group I has separate utility such as organizing the taxonomic information and identifying information associated with a organism based on a second name of the organism and the invention in Group II has separate utility such as creating a database of classifications. The Applicants respectfully disagree.

The invention in Group I relates to a method for use in managing taxonomic information, which includes identifying information associated with an organism based on the second taxonomic identifier. The invention in Group I identifies information associated with an organism. (*See Claim 32.*)

The invention in Group II is a system and method for use in managing taxonomic information in which a database of classifications is used to implement the method of organizing the information to help identify the information associated with the organism (*See Claim 40 and 41*). Invention II does not have separate utility of creating a database of classifications. A database of classification is implemented and used only as an element for the method and system of managing taxonomic information to help identify information associated with an organism. Hence, the invention in Group II “use[s] the classification to help identify information associated with an organism.” (*See Claim 40.*)

Since the Examiner has not demonstrated the invention in Group II has a utility other than in the disclosed combination the restriction is respectfully traversed. The Applicant should be allowed to have all claims examined on their merits.

Applicant also maintains that the restriction requirement is improper because the Examiner did not demonstrate that the search of the separate claims presents an undue burden on the Examiner.

Applicant also maintains that the restriction requirement is improper because the Examiner did not demonstrate that the search of the separate claims presents an undue burden on the Examiner.

Favorable action on the merits is respectfully requested. If there are any questions regarding this Response, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Applicants believe no additional fees are due with the filing of this Response. However, if any additional fees are required or if any funds are due, the Director is authorized to charge or credit Deposit Account Number: **50-0311**, Customer Number: **35437**, Reference Number: **2443-501-UTIL**.

Date: June 20, 2005



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